

Remarks/Arguments

After entry of this Amendment, claims 36-37, 39-41, and 122-126 will be pending for the Examiner's review and consideration. A Supplemental Information Disclosure Statement is also being submitted herewith.

Claim 38 has been canceled without prejudice. The right to prosecute any canceled subject matter in this application or in a subsequent continuation, continuation-in-part, or divisional application is hereby expressly reserved.

Claim 36 has been amended to include the recitations of previous claim 38. Claims 37 and 39 have been amended to recite what is believed to be clearer claim terminology. Claim 39 has also been amended to replace the term "solvent" with "polar liquid." This amendment is supported, for example, on page 17, lines 12 to 18; page 31, lines 9 to 15; and page 29, lines 3 to 8 of the specification as filed.

New claims 122-126 have been added. Claim 122 is supported, for example, on page 17, line 12 to page 18, line 19 and on page 29, lines 3 to 23 of the specification as filed. Claim 123 is supported, for example, on page 17, line 12 to page 18, line 19 and on page 29, lines 3 to 28 of the specification as filed. Claim 124 is supported, for example, on page 17, line 12 to page 18, line 19; page 29, lines 3 to 23; and page 31, lines 9 to 15 of the specification as filed. Claim 125 is supported, for example, on page 17, line 12 to page 18, line 19 and on page 29, lines 3 to 23 of the specification as filed. Claim 126 is supported, for example, on page 17, line 12 to page 18, line 19 and on page 29, line 3 to page 30, line 6 of the specification as filed. Accordingly, no new matter has been added to the claims by these amendments.

The undersigned appreciates the courtesies extended by Examiner Fortuna in the telephonic interview of May 1, 2008. In the Interview, the undersigned inquired about a discrepancy in the Office Action regarding its finality and the Examiner confirmed that the Office Action is a non-final action.

Claim Rejections – 35 U.S.C. § 112:

Claim 38 stands rejected under 35 U.S.C. § 112 as allegedly lacking antecedent basis for the term "solvent." It is believed, however, that claim 38 does not recite the

term “solvent,” and that the Office intended that the rejection apply to claim 39. Accordingly, claim 39 is addressed herein. This rejection has been rendered moot by the amendment of claim 39 to replace the term “solvent” with “polar liquid.” The term “polar liquid” finds clear antecedent basis in claim 36, from which claim 39 depends. Accordingly, it is believed that this ground of rejection has been overcome and should be withdrawn.

Claim Rejections – 35 U.S.C. § 103(a):

Claims 36, 37, 39, and 41 stand rejected under 35 U.S.C. § 103(a) as allegedly obvious over International publication No. WO 90/09385 (“WO ’385”) in view of the disclosure of the present application. This rejection is respectfully traversed for at least the reasons set forth below.

The Office’s indication that claim 38 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims is gratefully acknowledged. (Office Action, p. 4, ¶ 4).

Accordingly, claim 36, as amended, incorporates the subject matter of canceled claim 38 and recites a patch comprising, *inter alia*, a non-occlusive backing liner and an inner liner, wherein the backing liner and the inner liner define a reservoir, *wherein the non-occlusive backing liner exhibits a mean vapor transmission rate (MVTR) of more than 1000 g/m² day*. Claims 37, 39, and 41 depend from amended claim 36. Accordingly, it is believed that this ground of rejection has been overcome and should be withdrawn.

Claims 36, 37, 39, and 41 also stand rejected under 35 U.S.C. § 103(a) as allegedly obvious over International publication No. WO 00/44349 (“WO ’349”) in view of the disclosure of the present application. This rejection is respectfully traversed for at least the reasons set forth below.

As stated above, claim 36 has been amended to recite the language of claim 38, which the Office indicated would be allowable in rewritten in independent claim form. Accordingly, it is believed that this rejection has been overcome and should be withdrawn.

Moreover, it is respectfully submitted that the Office cannot apply WO ’349 against the present claims under 35 U.S.C. § 103(a) because WO ’349 is not available as

prior art. The Office contends that WO '349 constitutes prior art only under 35 U.S.C. § 102(e). WO '349 is *not* available as prior art under 35 U.S.C. § 102(e) because WO '349 was filed on January 26, 2000, which is before November 29, 2000. Publications of international applications filed before November 29, 2000 are subject to the pre-AIPA version of 35 U.S.C. § 102(e), which does not include publications of international applications. As stated in M.P.E.P. § 706.02(a)(II)(B):

Publications of international applications filed before November 29, 2000 (which would include WIPO publications and U.S. publications of the national stage (35 U.S.C. 371) do not have a 35 U.S.C. 102(e) date at all (however, such publications are available as prior art under 35 U.S.C. 102(a) or (b) as of the publication date). Specifically, under revised 35 U.S.C. 374, the international application must be filed on or after November 29, 2000 for its WIPO publication to be “deemed a publication under section 122(b)” and thus available as a possible prior art reference under 35 U.S.C. 102(e) as amended by the AIPA.

MPEP § 706.02(a)(II)(B) (8th ed., rev. 6, September 2007) (emphasis in original).

Further, even assuming *arguendo* that the Office could apply WO '349 as prior art against the present claims under 35 U.S.C. § 103(a), the Office has admitted that a liner having the mean vapor transmission rate recited in amended claims 36, 37, 39, and 41 is not taught by the prior art of record. Office Action, p. 4, discussed *supra*.

Accordingly, it is believed that the rejection of claims 36, 37, 39, and 41 under 35 U.S.C. § 103(a) as obvious over WO '349 in view of the disclosure of the present application cannot stand and should be withdrawn by the Office.

Claim Objections:

As stated above, claim 38 has been canceled and incorporated in pending claim 36. Claim 40 now includes all of the recitations of claim 38, because claim 40 depends from claim 36. Accordingly, it is believed that the Office's objections to claims 38 and 40 are now moot and should be withdrawn.

Appl. No. 10/037,480
Amdt. dated May 19, 2008
Reply to Office Action of January 9, 2008


Conclusion:

In view of the foregoing amendments and remarks, it is respectfully submitted that the claims are in condition for allowance. Early and favorable action by the Examiner is earnestly solicited. If any outstanding issues remain, the Examiner is invited to contact the undersigned at (212) 497-7731 to discuss the same.

No fee is believed to be due for the submission of this response. Should any fees be required, please charge all such fees to Wilson, Sonsini, Goodrich & Rosati Deposit Account No. 23-2415 (Docket No. 35946-703.301).

Respectfully submitted,

Dated: May 19, 2008

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